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**REMARKS**

Reexamination and reconsideration of the subject application, pursuant to and consistent with 37 C.F.R. § 1.112 are respectfully requested in light of the remarks which follow.

Applicants filed a First Information Disclosure Statement herein on July 3, 2003, together with the application papers. It is requested that an Examiner-initialed copy of applicants' Form PTO-1449 (one sheet) be returned to the undersigned with the next official communication.

It is also requested that the priorities claimed in the first paragraph on page 1 of the specification be duly acknowledged.

It is noted that the Examiner has indicated that Claims 1-69 are in this application. In point of fact, this application was filed with a total of 70 claims. Claim 70 appears at the top of page 39 of the application as originally filed. Claim 70 was apparently missed when the application was scanned at the USPTO, perhaps because most of the page on which it occurs is blank. Applicants tried to obtain a corrected filing receipt, but were told they had miscalculated the number of claims. That was not correct, since it is apparent from the Official Action that Claim 70 as filed is missing from the scanned copy of the application. Applicants enclose a copy of page 39 of the application as filed, showing Claim 70, together with a copy of their return postcard, date-stamped by the USPTO and indicating the receipt of Claims 1-70, 21 pages. A copy of Claim 70 as filed is appended and it is requested that this claim be added to the scanned copy so that the USPTO copy will accurately reflect what was actually filed. The Examiner will note that Claim 70 is identical to Claims 65-69, except for its dependency. Since Claim 70 depends from Claim 63 and

requires  $W = -CR^3$ , it would presumably be grouped with Group IV in the restriction requirement and will be treated as such in this response to the restriction/election requirement.

In response to the nine-way restriction requirement, applicants hereby elect, with traverse, the Group II invention, Claims 1-31 and 65-66 wherein  $W = -CR^3$ . These claims are drawn to a process for preparing a compound of formula (II) by adding  $SO_2$  to a mixture of a disulfide of formula (III), a formate salt, trifluoromethyl bromide and a polar solvent.

The restriction requirement is traversed in part. Specifically, in the event that the Examiner finds the elected Group II process patentable over the art, it is believed that it would be appropriate for him to also examine Groups IV and IX in this application. Group IV consists of Claims 32, 63, 64, 67 and 70 wherein  $W = -CR^3$ , while Group IX consists of Claims 61-62 and 69 wherein  $W = -CR^3$ .

In the case of Group IV, Claims 32 and 67 claim a two-step process, the first step of which is identical to the process of Claim 1. Therefore, if the process of the first step, which is the same as the process of Claim 1, is patentable over the art, the two-step process of Claims 32 and 67 (of which the Claim 1/Group II process is an indispensable part) would necessarily be patentable over the art as well. Moreover, the classification is the same and the fields of search should be coextensive. Thus, there would be no undue burden on the Examiner to examine these claims of Group IV together with those of the elected Group II if Group II is found to be patentable over the art.

Further with respect to Group IV, Claims 63, 64 and 70 are drawn to a three-step process, the second step of which is identical to the process of Claim 1.

Therefore, if the process of the second step, which is the same as the process of Claim 1, is patentable over the art, then the three-step process of Claims 63, 64 and 70 (of which the Claim 1/Group II process is an indispensable part) would necessarily be patentable over the art as well. Moreover, the fields of search should be coextensive and there would be no undue burden on the Examiner to examine these claims of Group IV together with those of the elected Group II if Group II is found to be patentable over the art.

Insofar as concerns Group IX, Claims 61-62 and 69, these claims are drawn to a two-step process, which comprises the first two steps of Group IV, Claims 63, 64 and 70; again, the second step is identical to the process of Claim 1. Therefore, if the process of the second step, which is the same as the process of Claim 1, is patentable over the art, then the two-step process of Group IX (of which the Claim 1/Group II process is an indispensable part) should be patentable over the art as well. Moreover, the fields of search should be coextensive and there would be no undue burden on the Examiner to examine the Group IX claims together with elected Group II.

In view of the foregoing, it is apparent that the processes of Groups IV and IX are intimately related to the process of elected Group II. For at least these reasons, it is requested that the restriction requirement be modified and that, in the event that the Examiner find the elected Group II subject matter allowable, he rejoin and examine Groups IV and IX herein as well. Moreover, it is pointed out that, contrary to page 4 of the Action, the inventions are not related as product and process of making; indeed, there are no product claims herein.

In response to the requirement for election of species, applicants would point out that applicants cannot elect a single compound, since no compounds are claimed; rather, applicants elect the process of Claim 1 wherein W is -CR<sup>3</sup>, R<sup>1</sup> is trifluoromethyl, R<sup>2</sup> is chloro and R<sup>3</sup> is chloro. All of Claims 1-31 read on this species, and Claims 29 and 31 are drawn specifically to the process wherein the disulfide of formula (III) and the compound of formula (II) have this structure, that is, the disulfide of formula (III) is 5-amino-1-(2,6-dichloro-4-trifluoromethylphenyl)-3 cyanopyrazol-4-yl disulfide and the compound of formula (II) is 5-amino-1-(2,6-dichloro-4-trifluoromethylphenyl)-3-cyano-4-trifluoromethylthiopyrazole.

It is also pointed out that all of the claims in Group IV (Claims 32, 67, 63, 64 and 70) and Group IX (Claims 61-62 and 69) read on a process which incorporates therein the process of Claim 1 wherein W is -CR<sup>3</sup>, R<sup>1</sup> is trifluoromethyl, R<sup>2</sup> is chloro and R<sup>3</sup> is chloro, as elected. Further, Claims 62 and 64 each specifically recite the same specific compounds of formulas (II) and (III) as recited in Claims 29 and 31.

Nevertheless, the election of species requirement is traversed because election of species normally presupposes that no generic claim is allowable and no art has been adduced which would militate against allowance of a generic claim herein such as, for example, Claim 1. The Examiner has already required restriction between the processes where W is nitrogen and those where W is -CR<sup>3</sup>, and the W = -CR<sup>3</sup> variant has been elected. It is believed that the remainder of the variables encompassed the structural formulas present an appropriate Markush group for examination; it is pointed out that the compounds of formula (III) in which W = CR<sup>3</sup> do not vary from one another except in the substituents on the phenyl ring, and then vary only within narrow bounds.

For the record, it is pointed out that Groups V and VI in the Official Action are identical. Presumably, the Examiner meant to specify W = CR<sup>3</sup> for Group VI.

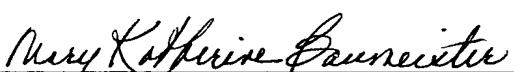
In light of the foregoing, an early Action on the merits is believed to be in order and is earnestly solicited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: May 17, 2004

By:



Mary Katherine Baumeister  
Registration No. 26,254

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

70. A process according to Claim 63, wherein:

R<sup>1</sup> is trifluoromethyl, trifluoromethoxy or -SF<sub>5</sub>;

W is -CR<sup>3</sup>;

R<sup>2</sup> is chlorine; and

R<sup>3</sup> is chlorine.



Inventor: Jean-Louis CLAVEL et al.

Appln. No. \_\_\_\_\_

Docket No.: 022650-726 Work Atty: MKB/cr Date: July 3, 2003

Title: PROCESS FOR PREPARING 4-TRIFLUOROMETHYLSULFINYL PYRAZOLE DERIVATIVE



The following was/were received in the U.S. Patent and Trademark Office on the date stamped hereon:

- Utility Patent Application Transmittal  
 Design Patent Application Transmittal  
 Continuing Prosecution Application Request  
 Provisional Application Cover Sheet  
 Provisional Application Transmittal  
 Continuation/Divisional Application (Rule 1.53(b)) with copy of application  
 Request for Continued Examination  
INCLUDING:  
 Specification (pages 1 - 19)  
 Claims (claim(s) 1 - 70, 21 pgs.)  
 Drawings (Fig(s). 1 - \_\_, \_\_ pgs.)  
 Abstract of the Disclosure (1 page)
- Copy of Executed Declaration/Power of Attorney from parent 10/111,000  
 Unexecuted Declaration/Power of Attorney  
 Assignment/Assignment Recordation Form Cover Sheet (PTO-1595)  
 Claim for Convention Priority w/\_ certified copy(s)  
 Preliminary Amendment  
 Information Discl. Stmt. Transmittal Letter  
 First Information Disclosure Citation (PTO-1449)  
 First Information Disclosure Statement w/copies of ISR & IPER  
 Petition for \_\_ Month Extension of Time  
 General Authorization for Petitions for Extensions of Time and Payment of Fees
- Check for \$ 1,902.00 is enclosed  
 Check for \$ \_\_ is enclosed  
 Charge \$ \_\_ to Deposit Account  
 Letter Accompanying Filing of Div. Appln. Under 37 C.F.R. § 1.53(b)

